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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/656,811 06/03/96 BARTSCH

D 50865/JPW/JM

EXAMINER

HM22/0807

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1185 AVENUE OF THE AMERICAS  
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PAK, M

ART UNIT

PAPER NUMBER

1646

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DATE MAILED:

08/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/656,811

Applicant(s)

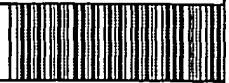
Bartsch et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on May 30, 2000.

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 3-6, 15, 16, and 18-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3-6, 15, 16, and 18-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on 30 May 2000 (Paper No. 23) has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicant's arguments filed 30 May 2000 (Paper No. 23) have been fully considered but they are not found persuasive.

***Claim Rejections - 35 USC § 112***

4. Claims 1, 3-6, 15-16, and 18-22 remains rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for improving implicit long term memory in invertebrate animal subjects such as Aplysia and Drosophila using the methods as claimed, does not reasonably provide enablement for all subjects suffering from a long term memory defects. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicants argue that long term facilitation in Aplysia is a long-accepted model for the study of long term memory in

primates. Applicants argue that both invertebrates and vertebrates share the cAMP signalling mechanism which are similar. It is not uncommon for certain basic structural features of neurons to remain conserved yet the evolution of neuronal connection is divergent between invertebrates and vertebrates. Although both vertebrates and invertebrates use ion channels for electrical signaling or cAMP for chemical signaling, invertebrates use non-myelinated giant axons whereas the vertebrates use myelinated axons. No one discounts the importance of invertebrate model systems for academic studies, but there is no nexus between the cAMP responsive element block in invertebrates and treatment in higher vertebrates such as primates including human. The importance of the model of Aplysia taught by Glanzman is not disputed, rather the nexus between the invertebrate and vertebrate model is disputed.

5. No claims are allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire

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on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
4 August 2000